

REMARKS/ARGUMENTS

Claims 1-17 and 19-52 were pending at the time of the mailing of the outstanding Office Action. Claims 1-6, 8, 14-17, 21-34, 41, 51, and 52 are under consideration and claims 7, 9-13, 19, 20, 35-40 and 42-50 are withdrawn from consideration. By this response, claim 1 is amended. No new claims have been added and no claims have been cancelled.

In the Office Action of 30 March 2005, the Examiner rejected claims 1, 2, 5, 6, 25 and 30 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over US Pat. No. 5,556,414 to Turi (hereinafter "Turi"). The Examiner rejected claims 4, 8, 22, 23, 27, 29, 32, 34, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Turi. Claims 3, 21, 24, 26, 28, 31, and 33 were rejected under 35 U.S.C. § 103(a) as obvious over Turi in view of US Pat. Pub. No. 2003/0208279 to Atala (hereinafter "Atala"). Claims 14-17 and 51-52 were rejected under 35 U.S.C. § 103(a) as unpatentable over Turi in view of US. Pat. No. 5,680,873 to Berg (hereinafter "Berg").

A personal interview was conducted on May 2, 2005. The undersigned attorney wishes to thank the Examiner for the courtesies extended during that interview. Claim 1 was discussed in light of the cited prior art. Specifically, the nature of the first and second parts of the stent as recited in claim 1 was discussed. The Examiner maintained that vein graft 26 of Turi, in its entirety, read on the elements of claim 1, "that a first part of the stent is disposed inwardly relative to a second part of the stent" in the first condition and that "at least a portion of the first part of the stent is not disposed inwardly relative to the second part of the stent" in the second condition. The Applicants maintain that Turi does not read on claim 1 because claim 1 recites that at least a portion of the first part (which is disposed inwardly in the first condition) is not disposed inwardly in the second condition. This requires a change in the relative position of at least a portion of the first part of the stent, which vein graft 26 of Turi does not provide. The Examiner maintained

that claim 1 did not adequately recite such a change in relative position. Agreement was not reached on this aspect of claim 1.

In light of the Examiner's comments during the interview of 2 May 2005, claim 1 has been amended to further recite that a portion of the first part of the stent changes position relative to the second part between the first and the second conditions. This change in position includes a change from at least a portion of the first part being disposed inwardly relative to the second part of the stent in the first condition, to that portion not being disposed inwardly relative to the second part in the second position. Such a change in relative position is not taught or suggested by Turi. Therefore, the Applicants maintain that claim 1 patentably distinguishes over the prior art. Likewise, claims 2-6, 8, 14-17, 21-34, 41, 51, and 52, which depend directly or indirectly from claim 1 and include all the limitations of claim 1 also patentably distinguish over the prior art.

Additionally, claims 2-6, 8, 14-17, 21-34, 41, 51, and 52 provide additional distinctions not taught or suggested in the prior art. For example, claims 6 and 30 recite the additional presence of a hardening agent. Contrary to the Examiner's assertion, the use of a hardening agent is not anticipated by the adhesive of Turi. While an adhesive can harden as it cures or dries, such a composition would be more properly characterized as a *hardenable* agent (i.e., the agent itself becomes hard) than a *hardening* agent (i.e., an agent that acts to cause or influence another component to harden). This distinction is clearly described in the specification, where the use of a hardening agent is described in paragraphs 0021-0026, while the use of an adhesive is described in paragraphs 0027-0033.

Because the cited prior art does not teach or suggest all of the limitations of claims 1-6, 8, 14-17, 21-34, 41, 51, and 52, withdrawal of the rejections of these claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is respectfully requested. In Atala, the stent is merely expanded from a first condition to a second condition with no change in

the relative position of the first and second parts of the stent. This element is also neither taught nor suggested by Berg, which provides a guide catheter.

In light of the amendments and arguments presented herein, reconsideration of claims 1-6, 8, 14-17, 21-34, 41, 51, and 52 is requested. As the Applicants maintain that generic claims 1-6, 8, 14-17, 21-34, 41, 51, and 52 patentably distinguish over the cited prior art, rejoinder of the non-elected claims of group I, claims 7, 9-13, 19, 20, 35-40 and 42-50, is also requested. The issuance of a Notice of Allowance is respectfully solicited.

The outstanding Office action was mailed on 30 March 2005. The Examiner set a shortened statutory period for reply of 3 months from the mailing date. Therefore, a response is timely filed on or before 30 June 2005.

No fees are believed to be due with this response. However, in the event that a fee for the filing of his response is insufficient, the Commissioner is authorized to charge any fee deficiency or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John J. Cunniff", with a stylized, sweeping flourish at the end.

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